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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/760,412

01/21/2004

Clive S. Lu

LU-016

1205

21884

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06/27/2006

WELSH & FLAXMAN LLC
2000 DUKE STREET, SUITE 100
ALEXANDRIA, VA 22314

EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/760,412

Applicant(s)

LU, CLIVE S.

Examiner

Stephen L. Blau

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 07 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18,19,21 and 23-33 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 18,19,21 and 23-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 18, 21, 23, and 26 are rejected under 35 U.S.C. 102(e) as being anticipated by VanderSchuit.

VanderSchuit discloses a grip in the form of a receptacle (700) for a beverage container (Figs. 7A-7B), a transparent polymeric body having a first end being closed [0084], a second end being open for attachment to an article, an inner surface defining a cavity shaped and dimensioned for receiving an article (Figs. 7A-7B), a design formed within the polymeric body between the inner and outer surface of the body [0027], a light source (712) coupled to the first end directing light within the polymeric body from the first end of the body to the second end of the body onto the design [0082], a grip substantially cylindrical (Figs. 7A-7B), an LED [0087], a light source being secured to the polymeric body (Figs. 7A-7B), and a grip shaped and dimensioned such that it is

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able to be attached to a golf club in the form that it has a cavity large enough to receive a shaft of a golf club and the grip is able to be attached using a fastener as tape (Figs. 7A, 7B).

Very little weight is give to the functional language of the grip shaped and dimensioned for attachment to a golf club. The grip of VanderSchuit is able to perform this function.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 24-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over VanderSchuit.

VanderSchuit discloses a power source within a compartment defined by a cap in the form of a bottom portion [0081], a cap in the form of a bottom portion coupled to a body (Figs. 7A-7B), and a light source being located at the cap (Figs. 7A-7B).

VanderSchuit lacks the light source being positioned within a cap. VanderSchuit discloses another embodiment (Fig. 1) with the light source being within [0036] a polymeric body [0030]. In view of the embodiment of figure 1 of VanderSchuit it would

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have been obvious to modify the grip embodiment of figure 7 of VanderSchuit to have the light source being positioned within a cap in order to protect the light source from damage due to setting down the grip on a surface or placing a beverage in the receptacle holder.

5. Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over VanderSchuit in view of Erokhin.

VanderSchuit discloses placing indicia into the material by using a laser [0129] and indicia being images and designs among others [0021].

VanderSchuit lacks a design being three dimensional.

Erokhin discloses creating laser-induced images (title) within three-dimension by altering the material characteristics of a (Col. 3, Lns. 7-10) transparent polymer material (Col. 5, Lns. 31-38) in order to provide decoration (Col. 1, Lns. 35-36). In view of the patent of Erokhin it would have been obvious to modify the grip of VanderSchuit to have a three dimensional design formed within a body and between the inner surface and the outer surface of a body wherein the design is a result of altering the appearance and material characteristics of the body between the inner and outer surface in order to provide a three dimensional design or emblem for indication and decorative purposes visually pleasing to a golfer.

6. Claims 18, 21, 23-27, and 29-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over VanderSchuit in view of Novak and Liou.

VanderSchuit discloses a grip in the form of a receptacle (700) for a beverage container (Figs. 7A-7B), a transparent polymeric body having a first end being closed [0084], a second end being open for attachment to an article, an inner surface defining a cavity shaped and dimensioned for receiving an article (Figs. 7A-7B), a design formed within the polymeric body between the inner and outer surface of the body [0027], a light source (712) coupled to the first end directing light within the polymeric body from the first end of the body to the second end of the body onto the design [0082], a grip substantially cylindrical (Figs. 7A-7B), an LED [0087], a light source being secured to the polymeric body (Figs. 7A-7B), other handles of tools with transparent material being lighted (Figs. 12A-C) and another embodiment (Fig. 1) with the light source being within [0036] a polymeric body [0030].

VanderSchuit lacks a golf club grip shaped and dimensioned for attachment to a shaft of a golf club and the light source being positioned within a cap.

Novak discloses grip material being transparent [0007] polymeric [0020], a grip for a golf club (Title), a first end being closed (Fig. 3) and a design in the form of an insert (Figs. 1,5) which can be seen through the transparent body (Fig. 1) for printing, design, color and emblem purposes [0022]. Liou discloses a light emitting golf ball practical for playing golf at night [0005]. In view of the references of Novak and Liou it would have been obvious to modify the grip of VanderSchuit to have a golf club grip shaped and dimensioned for attachment to a shaft of a golf club in order to utilize the advantages of lighted grips of VanderSchuit for golf clubs so logos are able to be seen

at night and in order to assist a player while playing a round of golf at night by being able to see not only the ball but the club grip as well.

In view of the embodiment of figure 1 of VanderSchuit it would have been obvious to modify the grip of VanderSchuit to have the light source being positioned within a cap in order to protect the light source from damage due to grip hitting different objects during use and stowage.

7. Claims 19 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over VanderSchuit in view of Novak and Liou as applied to claims 18, 21, 23-27, and 29-33 above, and further in view of Erokhin.

VanderSchuit discloses placing indicia into the material by using a laser [0129] and indicia being images and designs among others [0021].

VanderSchuit lacks a design being three dimensional.

Erokhin discloses creating laser-induced images (title) within three-dimension by altering the material characteristics of a (Col. 3, Lns. 7-10) transparent polymer material (Col. 5, Lns. 31-38) in order to provide decoration (Col. 1, Lns. 35-36). In view of the patent of Erokhin it would have been obvious to modify the golf club grip of VanderSchuit to have a three dimensional design formed within a body and between the inner surface and the outer surface of a body wherein the design is a result of altering the appearance and material characteristics of the body between the inner and outer surface in order to provide a three dimensional design or emblem for indication and decorative purposes visually pleasing to a golfer.

Response to Arguments

8. With respect to claim 18, the argument that VanderSchuit is improper due to VanderSchuit not disclosing utilization of his invention with a grip for a golf club is disagreed with. Claim 18 does not claim a golf club grip but a grip shaped and dimensioned for attachment to a golf club. The statement "shaped and dimensioned for attachment to a golf club" is considered a functional statement. Clearly the embodiment of figure 7 is able to perform this function. The argument that it is improper to use the reference of VanderSchuit for claim 27 since VanderSchuit discloses a diversity of articles but not a golf club grip and thus the examiner is using hindsight is disagreed with. VanderSchuit clearly states that there are more embodiments than those disclosed that would be obvious to use his teaching with [0005]. The examiner believes that a golf club grip is analogous art with the teaching of VanderSchuit since both deal with transparent devices/tools which are gripable with logos, emblems, designs and indicia. Due to the examiner making a new rejection for the amended claim 18 which is a combination of claims 18 and 20 this action is not made final.

Conclusion


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9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen L. Blau whose telephone number is (571) 272-4406. The examiner can normally be reached on Mon - Fri 10:00 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eugene Kim can be reached on (571) 272-4463. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SLB/ 22 June 2006



STEPHEN BLAU
PRIMARY EXAMINER